

## **REMARKS:**

Claims 1-8 and 10 are in the case and presented for consideration.

Claims 1-8 have been amended. The amendments to claim 1 find support throughout the originally filed specification.

Claim 9 has been canceled.

New claim 10 has been added.

## **INFORMATION DISCLOSURE STATEMENT**

In accordance with Examiner's comments, the prior art references listed in the search report have been listed in a Form 1449 which is submitted with this amendment. Additionally, legible copies of each of the listed references are also filed along with this amendment.

Therefore, the present application is now believed to be in compliance with 37 C.F.R. 1.98.

## **SPECIFICATION**

The specification has been amended so that it now contains proper section headings and thus is not believed to be in proper form

## **REJECTION OF CLAIMS UNDER 35 U.S.C. §112**

Claims 2, and 5-9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, and 5-8 have been amended in accordance with Examiner's comments

and claim 9 has been canceled. Therefore the claims are now believed to be in compliance with 35 U.S.C. 112, second paragraph.

#### FIRST REJECTION OF CLAIMS UNDER 35 U.S.C. §102(b)

Claims 1-8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,541,739 to Allen et al ("Allen").

This rejection is respectfully traverses.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See, e.g., *Verdeqaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This standard is not satisfied where the prior art reference merely discloses the "concept", "essence", "key" or "gist" of the patented invention "concepts do not anticipate." *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101 (Fed. Cir. 1985). To constitute anticipation, all the claimed elements must be found in exactly the same situation and united in the same way to perform the identical function in a single unit of prior art. *General Elect. Co. v. Nintendo Co., Ltd.*, 179 F.3d 1350 (Fed. Cir. 1999). Additionally, it is a settled matter of law that dependent claims contain all the elements of the claims from which they depend.

Allen fails to disclose or suggest several elements of currently amended independent claim 1, from which all other claims depend.

Allen does not disclose or suggest an upper race having “a bottom surface on which is provided a groove for accommodating a retaining ring and a cover disk, said retaining ring having an inner side and an outer side and said cover disk being positioned adjacent said inner side of said retaining ring” as claimed in currently amended independent claim 1.

Additionally, Allen fails to disclose or suggest both a race which “rotates at a rate of about 500,000 rotations per minute” and a ball bearing having “an outer diameter of 30mm or less” as claimed in currently amended independent claim 1.

Therefore because Allen fails to disclose several elements claimed in currently amended independent claim 1, from which all other claims depend, it cannot anticipate any of the claims currently in the case.

## SECOND REJECTION OF CLAIMS UNDER 35 U.S.C. §102(b)

Claims 1-7 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,744,862 to Schwartz (“Schwartz”).

Applicant respectfully traverses the Office's rejections that the claims of the present application are anticipated by the cited prior art.

Schwartz also fails to disclose several elements claimed in currently amended independent claim 1, from which all other claims depend.

Schwartz fails to disclose fibers which make up a “fibrous web” as claimed in currently amended independent claim 1.

Additionally, similar to Allen, Schwartz also does not disclose or suggest the

following elements of currently amended independent claim 1:

1) an upper race having “a bottom surface on which is provided a groove for accommodating a retaining ring and a cover disk, said retaining ring having an inner side and an outer side and said cover disk being positioned adjacent said inner side of said retaining ring;”

2) a race which “rotates at a rate of about 500,000 rotations per minute;” or

3) a ball bearing having “an outer diameter of 30mm or less.”

Therefore because Schwartz fails to disclose several elements claimed in currently amended independent claim 1, from which all other claims depend, it cannot anticipate any of the claims currently in the case.

### THIRD REJECTION OF CLAIMS UNDER 35 U.S.C. §102(b)

Claims 1-5 were rejected under 35 U.S.C. 102(b) as being anticipated by British Patent GB 1,215,668 to Johnson (“Johnson”).

The rejection is respectfully traversed.

As with the above two references, Johnson also fails to disclose or suggest several elements claimed in currently amended independent claim 1, from which all other claims depend.

Johnson fails to disclose or suggest both a “fibrous web” and a “heat cured epoxy resin.”

Additionally, Johnson does not disclose an upper race having “a bottom surface on which is provided a groove for accommodating a retaining ring and a cover disk, said retaining ring having an inner side and an outer side and said cover disk being positioned adjacent said inner side of said retaining ring;”

Therefore because Johnson fails to disclose several elements claimed in currently amended independent claim 1, from which all other claims depend, it cannot anticipate any of the claims currently in the case.

#### REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a)

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Allen, Schwartz, and Johnson, individually.

Applicants respectfully traverse the Office's rejection that the claims of the present application are obvious in view of the cited prior art.

As noted above, claim 9 has been canceled and its limitation incorporated into currently amended independent claim 1.

However, as discussed above, each of the cited references fail to disclose several elements claimed in currently amended independent claim 1. Furthermore, at least two of the missing elements are not disclosed in any of the three cited references. Additionally, with respect to the elements missing from all three cited references, the references also do not provide a teaching which would suggest to one of ordinary skill in the art to include the missing elements.

Furthermore, with respect to Allen, the disclosed ball bearing has cylindrical reservoirs within the cage. This means that the ball bearing is porous which is undesirable in light of the objects of the present invention. The higher the porosity, the less resistant the ball bearing is to the necessary autoclave treatments. Thus the ball bearing disclosed in Allen is not durable enough to be used in many medical and dental applications. It therefore follows that a person skilled in the art would not think to combine this aspect of Allen with the present invention.

In addition, with respect to Johnson, the fibers disclosed are glass fibers which are wound around the balls and on page 4 Johnson explicitly teaches to use phenol resins, not epoxy resins, at the elevated temperatures that ball bearings would encounter during the autoclave process.

Thus, in light of the above, neither Allen nor Johnson provide a teaching or suggestion which would motivate one of ordinary skill in the art to arrive at the presently claimed invention.

Moving on to Schwartz, column 1 states that the bearing retainer is useful in aerospace applications and thus in the low pressures and low temperatures which are found in the stratosphere. Accordingly, the ball bearings in Schwartz have a completely different field of use.

Furthermore, in column 3 line 20-26 Schwartz states that for higher temperatures carbon, graphite or boron fibers should be used and that for lower temperatures Teflon fibers should be used. Additionally, the use of epoxy resins are only disclosed for very low temperatures. Col. 3, ln. 34-35. Therefore, the teachings in Schwartz would lead one of ordinary skill away from the presently claimed combination.

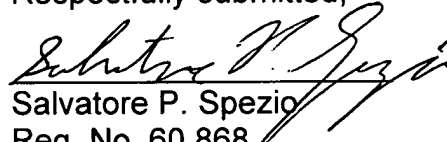
Therefore, because the aforementioned references fail to disclose several elements claimed in currently amended independent claim 1, from which all other claims depend, and because they do not provide teaching which would motivate one of ordinary skill in the art to arrive at the present invention, none of the current claims are obvious in light of the combination of Allen, Schwartz and Johnson.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested.

No new matter has been added.

If any issues remain, the Examiner is respectfully invited to contact the undersigned at the number below, to advance the application to allowance.

Respectfully submitted,

  
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